

REMARKS

Summary of the Office Action

Claims 1-2, 5-6, 11-12, 15-18, and 21-23 have rejected under 35 USC 103(a) as obvious over European Patent No. 1 057 460 to Tower et al. (“Tower”) view of International Patent Publication No. WO 96/26682 to Globerman et al. (“Globerman”) and U.S. Patent No. 6,071,305 to Brown et al. (“Brown”).

Claims 7 and 8 have been rejected under 35 USC 103(a) as obvious over Tower in view of Globerman and Brown, and further in view of U.S. Patent Application Publication No. 2002/0038146 to Harry (“Harry”).

Response to the Office Action

Claims 1-23 are pending in the application, of which claims 3-4, 9-10, 13-14 and 19-20 have been withdrawn from examination. In the present amendment, claims 1-2 have been amended, claim 11 has been canceled, and new claim 25 has been added. Therefore, after entry of the present amendment, claims 1-2, 5-8, 12, 15-18 and 21-23 and 25 will be subject to examination.

A. Introduction

This application comes before the Examiner after two Requests for Continued Examination and a plurality of Office Actions and related responses. Throughout prosecution, various references have been cited, some of which have been withdrawn during one Office Action but have been cited again in a successive Office Action. For example, Tower, Globerman and Brown were cited in the Office Action dated July 5, 2006, withdrawn in the Office Action dated January 8, 2007, and are cited again in the present Office Action.

Assignee Abbott is seeking to have the present application approved as expeditiously as possible. To resolve minor issues, the Examiner is invited to contact the undersigned attorney by telephone at (858) 720-6368.

B. *The Rejections under 35 USC 103(a)*

The rejections of the pending claims have been based on allegations that combinations of the cited prior art references render Applicant's invention obvious. As the Supreme Court has administered, "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." Instead, "it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." Hindsight – that is, using Applicant's invention as a blueprint – must be avoided. *KSR v. Teleflex*, 550 US ____ (2007).

With reference to claims 1-2, 5-6, 11-12, 15-18 and 21-23, Tower discloses a cardiac valve assembly that includes a radially expandable intravascular stent defined by a plurality of cylindrical fine wire sections, each made from a highly malleable material that has been fully annealed to remove as much spring memory as possible. A preferred embodiment includes a stent made of a combination of 90% platinum and 10% iridium. *See* Tower, paragraphs 1, 17 and 26.

Globerman discloses an implantable medical device such as a stent that has a tubular rather than a solid structure. While Globerman describes the objective of his invention as providing a stent with improved mechanical properties, Globerman also discloses that the lumen of the tubular material may contain radiopaque or pharmacologic substances and have miniature openings. *See* Globerman, page 4, lines 2-5; page 7, lines 11-16.

Brown discloses a directional drug delivery stent, in which a cavity may contain a biocompatible delivery matrix that is biodegradable and includes a polymer. *See* Brown, Abstract; col. 8, line 61- col. 9, line 4.

Concerning claims 7-8, Harry discloses an expandable stent formed by interconnected struts having relief cuts. The interconnected struts are not hollow, and each of the relief cuts extends through the entire thickness of a strut. *See* Harry, paragraphs 38 and 49.

Tower, Globerman and Brown cannot be combined to produce Applicant's invention, because Tower expressly requires that the stent be produced from "fine wire," while the structure of Globerman and Tower requires a hollow wire (therefore, an inherently "thick wire") to provide the structure described in those references. Therefore, Tower teaches away from Globerman and Brown, rendering the teachings of Tower, Globerman and Brown inapposite and not combinable.

The Examiner has asserted that it would have been obvious to combine these references because "[t]he modification provides the doctor [with] the ability to treat the patient locally at a diseased or stenosed region in a patient's blood vessel." Applicant respectfully submits that this argument runs counter to the Supreme Court's admonition "that a patent claim cannot be proved obvious merely by showing that the combination of elements was 'obvious to try,'" because no reason has been provided, nor one is apparent, why a person skilled in the art would have utilized the constructive structure of Tower, rather than an alternative construction, to produce Applicant's claimed invention in spite of Tower's teachings that the stent be manufactured with materials different from Applicant's, that is, with "fine" wires that are malleable and that are further annealed to remove any residual stress.

Based on the foregoing, Applicant submits that the obviousness rejection of claims 1-2, 5-6, 11-12, 15-18 and 21-23 cannot stand.

Concerning claims 7-8, Harry teaches the use of through slots, not pores. As quoted above, "a patent claim cannot be proved obvious merely by showing that the combination of elements was 'obvious to try'." *KSR, supra*. The Examiner has asserted that pore sizes might be varied "to provide different amounts of therapeutic material released from the stent," but no reason is provided why a person skilled in the art would have looked at Harry's through-slots (introduced to alter mechanical properties) to devise a stent having differential pore distributions as claimed by Applicant.

C. New Claim 25

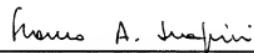
New claim 25 is directed to a stent, in which each circumferential ring is a continuous hollow tube. Claim 25 is fully supported in the specification and is not anticipated by Tower, Globerman or Brown.

Conclusion

In view of the foregoing amendments and remarks, Applicant submits that the present application is now in condition for allowance. Reexamination and reconsideration of the pending claims are respectfully requested.

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Respectfully submitted,



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